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David Cooper

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EXAMINER

PHAN, HUY Q

ART UNIT

PAPER NUMBER

2617

MAIL DATE

DELIVERY MODE

08/10/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/589,217

Applicant(s)

COOPER, DAVID

Examiner

Huy Q. Phan

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3,5,8-10,16-18,20,21,25,28 and 29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3,5,8-10,16-18,20,21,25,28 and 29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This Office Action is in response to Amendment filed on date: 06/21/2007.
Claims 3, 5, 8-10, 16-18, 20, 21, 25, 28 and 29 are still pending.

Response to Arguments

2. Applicant's arguments with respect to claims 3, 5, 8-10, 16-18, 20, 21, 25, 28 and 29 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

A) Claims 3 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tiedemann, Jr. (US-5,940,761; previously cited) in view of Bridges (US-6,148,197; previously cited) and further in view of Daly (US-6,122,503).

Regarding claim 3, Tiedemann, Jr. discloses a method of facilitating handover (fig. 2 and its description) from an active network (original system S1) with which user equipment (M1-M3) is in communication to another network (destination system S2), the method comprising the steps of:

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receiving from user equipment communicating via the active network an indication of at least one preferred other network ("reports its finding"; col. 11, lines 36-43; also see col. 7, lines 45-59); and

in response thereto, providing to the user equipment via the active network neighbor cell information for the at least one preferred other network (col. 5, lines 9-15, also see fig. 2 and its description). But, Tiedemann, Jr. does not particularly show the steps of transmitting to the user equipment a first list having a plurality of unique network identifiers; and comparing the first list with a second list which includes at least one unique network identifier from the plurality of unique network identifiers and is internally stored in the user equipment for selectively communicating with at least one of a plurality of networks, the comparison being performed by the user equipment.

However in analogous art, Bridges teaches the steps of transmitting to the user equipment a first list having a plurality of unique network identifiers (col. 12, lines 66-67 and col. 13, lines 34-38; for more details see cols. 11-15 and 25-29); and comparing (col. 6, line 53-col. 7, line 5 and/or inherently for "the mobile may select the most appropriate system for that region", see col. 12, lines 1-6) the first list with a second list (fig. 2C, "PSL/IRDB") which includes at least one unique network identifier from the plurality of unique network identifiers and is internally stored in the user equipment for (see col. 8, lines 50-67) selectively communicating with at least one of a plurality of networks, the comparison being performed by the user equipment (col. 6, line 53-col. 7, line 5 and/or inherently for "the mobile may select the most appropriate system for that region", see col. 12, lines 1-6); therefore, it would have been obvious to one of ordinary

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skill in the art at the time the invention was made to modify the system of Tiedemann, Jr. as taught by Bridges "so as to obtain service from the highest priority wireless carrier available" (see col. 7, lines 1-5).

But, Tiedemann, Jr. and Bridges do not particularly show the at least one network identifier in the second list is an identifier of a network that is never to be used. However in analogous art, Daly teaches the at least one network identifier in the list is an identifier of a network that is never to be used ("forbidden" see col. 8, lines 15-27); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Tiedemann, Jr. and Bridges as taught by Daly in order to "control the intelligent roaming function" of the user equipment since the intelligent roaming is "a process that a mobile station or phone goes through to assure that it is receiving the best service possible regardless of the location that the phone is in" (see col. 1, lines 20-25 and col. 8, lines 13-15).

Regarding claim 25, Tiedemann, Jr. discloses a mobile communications network (fig. 2 and its description) or component thereof including:

means for receiving from user equipment communicating with the network an indication of a preferred other network ("reports its finding"; col. 11, lines 36-43; also see col. 7, lines 45-59); and

means for supplying neighboring cell information for the preferred other network (col. 5, lines 9-15, also see fig. 2 and its description). But, Tiedemann, Jr. does not particularly show means for receiving by the user equipment a first list having a plurality

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of unique network identifiers; and means for comparing by the User equipment the received first list with a second list which includes at least one unique network identifier from the plurality of unique network identifiers and is internally stored in the user equipment. However, Bridges teaches means for receiving by the user equipment a first list having a plurality of unique network identifiers (col. 12, lines 66-67 and col. 13, lines 34-38; for more details see cols. 11-15 and 25-29); and means for comparing (col. 6, line 53-col. 7, line 5 and/or inherently for "the mobile may select the most appropriate system for that region", see col. 12, lines 1-6) by the user equipment the received first list with a second list (fig. 2C, "PSL/IRDB") which includes at least one unique network identifier from the plurality of unique network identifiers and is internally stored in the User equipment (see col. 8, lines 50-67); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Tiedemann, Jr. as taught by Bridges "so as to obtain service from the highest priority wireless carrier available" (see col. 7, lines 1-5).

But, Tiedemann, Jr. and Bridges do not particularly show the at least one network identifier in the second list is an identifier of a network that is never to be used. However in analogous art, Daly teaches the at least one network identifier in the list is an identifier of a network that is never to be used ("forbidden" see col. 8, lines 15-27); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Tiedemann, Jr. and Bridges as taught by Daly in order to "control the intelligent roaming function" of the user equipment since the intelligent roaming is "a process that a mobile station or phone goes through to assure

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that it is receiving the best service possible regardless of the location that the phone is in" (see col. 1, lines 20-25 and col. 8, lines 13-15).

B) Claims 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bridges (US-6,148,197; previously cited) in view of Daly (US-6,122,503).

Regarding claim 28, Bridges discloses a method of using user equipment (fig. 2C) for a mobile communication system (fig. 2A) comprising:

receiving a first list including a plurality of network identifiers (col. 12, lines 66-67 and col. 13, lines 34-38; for more details see cols. 11-15 and 25-29); and

comparing (col. 6, line 53-col. 7, line 5 and/or inherently for "the mobile may select the most appropriate system for that region", see col. 12, lines 1-6) the received first list with a second list (fig. 2C, "PSL/IRDB") which includes at least one network identifier and is stored in the user equipment (see col. 8, lines 50-67).

But, Bridges does not particularly show the at least one network identifier in the second list is an identifier of a network that is never to be used. However in analogous art, Daly teaches the at least one network identifier in the list is an identifier of a network that is never to be used ("forbidden" see col. 8, lines 15-27); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Bridges as taught by Daly in order to "control the intelligent roaming function" of the user equipment since the intelligent roaming is "a process that a mobile station or phone goes through to assure that it is receiving the best service

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possible regardless of the location that the phone is in" (see col. 1, lines 20-25 and col. 8, lines 13-15).

Regarding claim 29, Bridges discloses user equipment (fig. 2C) for a mobile communication system (fig. 2A) comprising:

means for receiving a first list including a plurality of network identifiers (col. 12, lines 66-67 and col. 13, lines 34-38; for more details see cols. 11-15 and 25-29); and

means for comparing (col. 6, line 53-col. 7, line 5 and/or inherently for "the mobile may select the most appropriate system for that region", see col. 12, lines 1-6) the received first list with a second list (fig. 2C, "PSL/IRDB") which includes at least one network identifier and is stored in the user equipment (see col. 8, lines 50-67).

But, Bridges does not particularly show the at least one network identifier in the second list is an identifier of a network that is never to be used. However in analogous art, Daly teaches the at least one network identifier in the list is an identifier of a network that is never to be used ("forbidden" see col. 8, lines 15-27); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the user equipment of Bridges as taught by Daly in order to "control the intelligent roaming function" of the user equipment since the intelligent roaming is "a process that a mobile station or phone goes through to assure that it is receiving the best service possible regardless of the location that the phone is in" (see col. 1, lines 20-25 and col. 8, lines 13-15).

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C) Claims 16-18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Den Heuvel (US-6,223,030; previously cited) in view of Bridges and further in view of Daly (US-6,122,503).

Regarding claim 16, Van Den Heuvel discloses a user equipment (SU 20) for a mobile communications system capable of handover from an active network (communication system 19) with which user equipment is in communication to another network (UMTS 14) (fig. 1 and col. 1, lines 50-65; also see cols. 3-4) comprising: means for storing a second list of available other networks supplied by the active network (fig. 6 and col. 5, lines 18-24); means for transmitting from the user equipment an indication of a preference for a network (fig. 1 and col. 1, lines 59-65).

But, Van Den Heuvel does not particularly show means for receiving a first list having a plurality of unique network identifiers, and means for comparing the received first list with a second list which includes at least one unique network identifier from the plurality of unique network identifiers and is internally stored in the user equipment for selectively communicating with at least one of a plurality of networks. However in analogous art, Bridges teaches means for receiving a first list having a plurality of unique network identifiers (col. 12, lines 66-67 and col. 13, lines 34-38; for more details see cols. 11-15 and 25-29); and means for comparing (col. 6, line 53-col. 7, line 5 and/or inherently for "the mobile may select the most appropriate system for that region", see col. 12, lines 1-6) the received first list with a second list (fig. 2C, "PSL/IRDB") which includes the at least one unique network identifier from the plurality of unique network identifiers and is internally stored in the user equipment (see col. 8,

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lines 50-67) for selectively communicating with at least one of a plurality of networks (col. 6, line 53-col. 7, line 5 and/or inherently for "the mobile may select the most appropriate system for that region", see col. 12, lines 1-6); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Van Den Heuvel as taught by Bridges "so as to obtain service from the highest priority wireless carrier available" (see col. 7, lines 1-5).

But, Van Den Heuvel and Bridges do not particularly show the at least one network identifier in the second list is an identifier of a network that is never to be used. However in analogous art, Daly teaches the at least one network identifier in the list is an identifier of a network that is never to be used ("forbidden" see col. 8, lines 15-27); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Van Den Heuvel and Bridges as taught by Daly in order to "control the intelligent roaming function" of the user equipment since the intelligent roaming is "a process that a mobile station or phone goes through to assure that it is receiving the best service possible regardless of the location that the phone is in" (see col. 1, lines 20-25 and col. 8, lines 13-15).

Regarding claim 17, Van Den Heuvel, Bridges and Daly disclose the user equipment according to claim 16. Bridges further discloses that comprising means for updating the stored list of available other networks based on information supplied by the active network (col. 15, lines 35-45).

Regarding claim 18, Van Den Heuvel discloses a user equipment (SU 20) for a mobile communications system capable of handover from an active network (communication system 19) with which the user equipment is in communication to another network (UMTS 14) (fig. 1 and col. 1, lines 50-65; also see cols. 3-4) comprising means for transmitting from the User equipment an indication of a preference for a network (fig. 1 and col. 1, lines 59-65). But, Van Den Heuvel does not particularly show means for receiving a first list having a plurality of unique network identifiers; and means for storing a second list of available other networks supplied by the active network; means for comparing the received first list with a second list which includes at least one unique network identifier from the plurality of unique network identifiers and is internally stored in the user equipment for selectively communicating with at least one of a plurality of networks; means for updating the second list of available other networks based on information supplied by the active network. However in analogous art, Bridges teaches means for receiving a first list having a plurality of unique network identifiers (col. 12, lines 66-67 and col. 13, lines 34-38; for more details see cols. 11-15 and 25-29), means for storing a second list of available other networks supplied by the active network (col. 15, lines 35-45); means for comparing the received first list with a second list (fig. 2C, "PSL/IRDB") which includes at least one unique network identifier from the plurality of unique network identifiers and is internally stored in the user equipment (see col. 8, lines 50-67) for selectively communicating with at least one of a plurality of networks (col. 6, line 53-col. 7, line 5 and/or inherently for "the mobile may select the most appropriate system for that region", see col. 12, lines 1-6); means for updating the

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second list of available other networks based on information supplied by the active network (col. 15, lines 35-45); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Van Den Heuvel as taught by Bridges "so as to obtain service from the highest priority wireless carrier available" (see col. 7, lines 1-5).

But, Van Den Heuvel and Bridges do not particularly show the at least one network identifier in the second list is an identifier of a network that is never to be used. However in analogous art, Daly teaches the at least one network identifier in the list is an identifier of a network that is never to be used ("forbidden" see col. 8, lines 15-27); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Van Den Heuvel and Bridges as taught by Daly in order to "control the intelligent roaming function" of the user equipment since the intelligent roaming is "a process that a mobile station or phone goes through to assure that it is receiving the best service possible regardless of the location that the phone is in" (see col. 1, lines 20-25 and col. 8, lines 13-15).

Regarding claim 20, Van Den Heuvel, Bridges and Daly disclose the user equipment according to claim 18. Bridges further discloses that comprising means for storing network preference information (col. 15, lines 35-45).

D) Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tiedemann, Jr., Bridges and Daly in view of Chang (US-6,272,315; previously cited).

Regarding claim 5, Tiedemann, Jr., Bridges and Daly disclose the method according to claim 3. But, Tiedemann, Jr., Bridges and Daly do not particularly show a step of incrementally adding to or subtracting from the list of available networks. However in analogous art, Chang teaches a step of incrementally adding to or subtracting from the list of available networks (col. 7, lines 16-22); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Tiedemann, Jr., Bridges and Daly as taught by Chang Heuvel for purpose of providing the user with the most needed information of the available networks in order to increase significantly the efficiency of wireless communication service.

E) Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Den Heuvel in view of Bridges, in view of Daly, further in view of Chang.

Regarding claim 8, Van Den Heuvel discloses a method (fig. 1 and col. 50-65) of operating the User equipment capable of handover between an active network (communication system 19) and another network (UMTS 14) comprising a stored list of available networks based on information supplied by the active network with which the User equipment is in communication (col. 2, lines 54-55 and also see cols. 3-4).

But, Van Den Heuvel does not particularly show receiving a first list having a plurality of unique network identifiers, storing a preference for a network in a second list having at least one unique network identifier from the plurality of unique network identifiers and is internally stored in the User equipment; comparing the received first list

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with the second list which includes the at least one unique network identifier for selectively communicating with at least one of a plurality of networks. However in analogous art, Bridges teaches receiving a first list having a plurality of unique network identifiers (col. 12, lines 66-67 and col. 13, lines 34-38; for more details see cols. 11-15 and 25-29), storing a preference for a network in a second list (fig. 2C, "PSL/IRDB") having the at least one unique network identifier from the plurality of unique network identifiers and is internally stored in the User equipment (fig. 2C, "PSL/IRDB"); comparing (col. 6, line 53-col. 7, line 5 and/or inherently for "the mobile may select the most appropriate system for that region", see col. 12, lines 1-6) the received first list with the second list which includes at least one unique network identifier for selectively communicating with at least one of a plurality of networks (col. 6, line 53-col. 7, line 5 and/or inherently for "the mobile may select the most appropriate system for that region", see col. 12, lines 1-6); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Van Den Heuvel as taught by Bridges "so as to obtain service from the highest priority wireless carrier available" (see col. 7, lines 1-7).

But, Van Den Heuvel and Bridges do not particularly show the at least one network identifier in the second list is an identifier of a network that is never to be used. However in analogous art, Daly teaches the at least one network identifier in the list is an identifier of a network that is never to be used ("forbidden" see col. 8, lines 15-27); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Van Den Heuvel and Bridges as taught by

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Daly in order to "control the intelligent roaming function" of the user equipment since the intelligent roaming is "a process that a mobile station or phone goes through to assure that it is receiving the best service possible regardless of the location that the phone is in" (see col. 1, lines 20-25 and col. 8, lines 13-15).

But, Van Den Heuvel, Bridges and Daly do not particularly show a step of incrementally adding to or subtracting from the list of available networks. However in analogous art, Chang teaches a step of incrementally adding to or subtracting from the list of available networks (col. 7, lines 16-22); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Van Den Heuvel, Bridges and Daly as taught by Chang for purpose of offering the user with the most needed information of the available networks in order to provide the most efficient wireless communication service.

Regarding claim 9, Van Den Heuvel, Bridges, Daly and Chang disclose method of claim 8. Van Den Heuvel further discloses a step of signaling to the active network (communication system 19) with which the User equipment is in communication a preferred other network (UMTS 14) for handover (col. 1, lines 50-65 and also see cols. 3-4).

Regarding claim 10, Van Den Heuvel, Bridges, Daly and Chang disclose method of claim 9. Van Den Heuvel further discloses wherein said preferred other network is

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selected by the User equipment from a list of available networks supplied by the network (col. 1, lines 50-65).

F) Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Van Den Heuvel, Bridges and Daly in view of Gourgue (US-6,584,116; previously cited).

Regarding claim 21, Van Den Heuvel, Bridges and Daly disclose the user equipment according to claim 16. But, Van Den Heuvel, Bridges and Daly do not particularly show wherein the active network is a UMTS network and the other network is a GSM network, having means for communicating over both networks. However in analogous art, Gourgue teaches wherein the active network is a UMTS network and the other network is a GSM network, having means for communicating over both networks (col. 2, lines 15-45); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Van Den Heuvel, Bridges and Daly as taught by Gourgue for purpose of allowing the user equipment with capability continuously communicating while moving from UMTS network to GSM network.

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a) Zicker discloses that "storing a list of system identification numbers (SIDs) that identify cellular base systems for which cellular radiotelephone communication with said CMR is to be prohibited" (see specification).

b) Kolev discloses that "The subscriber is then given an opportunity in step 122 to alter some of the stored operational data, for example, the selection of a satellite or terrestrial cellular telecommunications system provider and identify a list of forbidden providers" (see specification).

c) Shah discloses that the user equipment is "given a list of service providers that are forbidden to be used" (see specification).

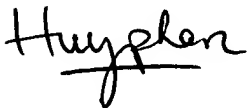
Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huy Q Phan whose telephone number is 571-272-7924. The examiner can normally be reached on 8AM-6PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on 571-272-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Examiner: Phan, Huy Q.

AU: 2617

Date: 08/03/2007


GEORGE ENG
SUPERVISORY PATENT EXAMINER